

**REMARKS**

Claims 12, 14-22 and 88-118 are currently pending in the application. Applicant has canceled claims 13, 76-78 and 81-87, amended claims 12, 14-19 and 21-22 and added claims 88-118. Applicants request reconsideration of the application in light of the following remarks.

**Rejections under 35 U.S.C. §112**

Claims 76-78 and 81-87 stand rejected by the Examiner under 35 U.S.C. 112. Pursuant to the present amendments, these claims have been canceled, obviating the rejection of these claims under 35 U.S.C. 112. Accordingly, Applicant respectfully requests that the rejection of claims 76-78 and 81-87 under 35 U.S.C. § 112 be withdrawn.

**Rejections under 35 U.S.C. §102**

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claims 15-19 were rejected under 35 U.S.C. § 102(b) as being anticipated by Dedrick (U.S. Patent No. 5,717,923, hereinafter "Dedrick"). Applicants respectfully traverse this rejection and request reconsideration of the claims.

Dedrick discloses a method and apparatus for customizing electronic advertising to individual targeted consumers based upon a personal consumer profile for each targeted

consumer. *See* Dedrick Abstract. The system compares the personal consumer profile for a particular targeted consumer with available electronic content and format when the targeted consumer accesses an Internet site. This comparison dictates the format and content of the electronic advertisements for that targeted consumer based upon whatever information has been gathered for the consumer. *See Id.* at col. 6, line 33 to col. 7, line 22. The more information the consumer provides or that is stored in the consumer profile database, the more like the consumer's profile the electronic content and format will appear. *Id.* The Dedrick system is only applied to individual targeted consumers for which individual data regarding the targeted consumer is available.

Independent claim 15, as amended, recites an "advertising plan optimization mechanism iteratively modifying an advertising plan to achieve one of an improved or optimal advertising plan . . . ." This claim was amended during the present Amendment, like the other claims, to bring the claim language closer to that used in the specification and not for any reasons related to patentability. Dedrick does not disclose *iteratively* modifying any advertising plan. While the system of Dedrick apparently provides different advertising content and format to the targeted consumer if different information is included in the targeted consumer's profile, any changes to any advertising "plan" for the consumer are not done iteratively. Iterative modification takes into account the results of prior iterations. Dedrick establishes its format and content regardless of prior consumer advertising schemes.

Unlike the system of Dedrick, the program product of claim 15 includes an advertising plan optimization mechanism that iteratively modifies an advertising plan. This is unlike the system of Dedrick and is not disclosed by Dedrick. Accordingly, the disclosure of Dedrick does not anticipate independent claim 15. Dependent claims 16-19 are allowable over Dedrick, among other reasons, for depending from allowable claim 15.

Applicants respectfully request that the anticipation rejections of claims 15-19 be withdrawn.

Additionally, newly added claim 118, recites that the advertising plan is iteratively modified using at least one of an exposure valuation index, an audience valuation index and an exposure recency index. Dedrick does not track or contemplate prior consumer exposure to particular advertisements or rely upon any exposure valuation index or exposure recency index for determining any advertising plan for its consumers. Additionally, Dedrick does not disclose any audience valuation index as claimed by claim 118 or rely upon it in determining any advertising plan for its consumers.

### **Rejections under 35 U.S.C. §103**

To establish a *prima facie* case of obviousness under 35 U.S.C. §103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited prior art reference must teach or suggest all of the claim limitations. Furthermore, the suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based upon the Applicants' disclosure. A failure to meet any one of these criteria is a failure to establish a *prima facie* case of obviousness. MPEP §2143.

### **Claims 12-14 and 20-22**

Claims 12-14 and 20-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dedrick, in view of Chipolla. Dependent claim 13 has been canceled,

obviating the rejection of that claim. Applicants respectfully traverse the rejection of claims 12, 14 and 20-22 and request reconsideration of these claims.

The most recent Office Action asserts that all of the elements of independent claim 12 are found in Dedrick except for a database mining engine, which it finds in Cipolla. The Dedrick system is specifically directed to and applicable only for advertising in which individual people receive individually selected advertisements targeted to them through the Internet. *See* Dedrick Abstract and remainder of disclosure. Without the information relating to the particular targeted individual, no advertising for that individual is selected for display. The data in the database relates to and indicates the consumer or user's demographic information and preferences. *See Id.* at col. 5, line 50 to col. 6, line 3.

The computer system of claim 12 recites a database containing "audience member data indicating exposure of each corresponding audience member to at least one of media and advertisements" and a "user interface [that] provides a plurality of choices for improving and optimizing an advertising plan for presentation to a plurality of audience members . . . ." Dedrick does not teach or suggest storage of any data that indicates exposure of audience members to media and advertisements, or any interface that provides choices for improving or optimizing an advertising plan for presentation to a plurality of audience members. Cipolla does not disclose anything to change this reading of Dedrick. Accordingly, the combined teachings and suggestions of Dedrick and Cipolla are insufficient to make claim 12 obvious.

The fundamental difference between the systems and methods disclosed in Applicant's specification and that in Dedrick's patent is that Dedrick is only for targeted advertising where specific information about specific consumers is known and Applicant's inventions are not. Dedrick assists the computer to select a targeted advertisement for a specific, individual consumer. Applicant's disclosure explains how to organize an advertising plan for presentation to a large audience without knowledge of the specific

audience members. Applicant's disclosure explains how to position an advertisement (optimal station, optimal media, optimal time, optimal network, optimal location in a magazine or newspaper, optimal frequency of presentation, etc.) by identifying exposure likelihoods and assigning values to evaluate them by. In other words, Applicant's disclosure answers the question, "What is the best situation for presenting a particular advertisement in an advertising plan to which many people will be exposed?" Dedrick answers the questions, "What is the best advertisement to select for presentation to this specific consumer and how should the presentation be customized for this specific consumer?" These are fundamentally distinct questions and the inventions to resolve these questions are also fundamentally different. Application of the Dedrick system and Applicant's system are mutually exclusive in that Dedrick requires specific knowledge of a specific targeted audience member to operate, and Applicant's system selects an advertising plan that involves no specific audience members.

The combined teachings of Dedrick and Cipolla are insufficient in that they do not disclose every element of independent claim 12. Accordingly, claim 12 is allowable. Dependent claims 14 and 20-22 are allowable over the combination of Dedrick and Cipolla, among other reasons, for depending from allowable claim 15. Like Dedrick, Cipolla does not disclose an advertising plan optimization mechanism that iteratively modifies an advertising plan. Cipolla relates to presenting the information in a database in a more convenient form. Applicants respectfully request that the obviousness rejections of claims 12, 14 and 20-22 be withdrawn.

In summary, and in view of the amendments herein, none of the references cited by the Examiner nor any other known prior art, either alone or in combination, disclose the unique combination of features disclosed in Applicant's claims presently on file. For this reason, allowance of all of Applicants' claims is respectfully solicited.

**Regarding Doctrine of Equivalents**

Applicants hereby declare that any amendments herein that are not specifically made for the purpose of patentability are made for other purposes, such as clarification, and that no such changes shall be construed as limiting the scope of the claims or the application of the Doctrine of Equivalents.

**CONCLUSION**

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

It is requested that a three-month extension of time be granted for the filing of this response, and the appropriate extension filing fee of \$465.00 is enclosed herewith. The amendments herein added 4 new independent and 27 new dependent claims, resulting in fees due of \$96.00. A check in the amount of \$561.00 has been included herewith for these purposes.

If any fees, including extension of time fees or additional claims fees, are due as a result of this response, please charge Deposit Account No. 19-0513. This authorization is intended to act as a constructive petition for an extension of time, should an extension of time be needed as a result of this response. The examiner is invited to telephone the undersigned if this would in any way advance the prosecution of this case.

Respectfully submitted,

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By Kenneth C. Booth  
Kenneth C. Booth  
Reg. No. 42,342

**SCHMEISER, OLSEN & WATTS LLP**  
18 East University Drive, #101  
Mesa, AZ 85201  
(480) 655-0073